


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 12587-015001
I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.	Application Number 09/879,267	Filed June 12, 2001
	First Named Inventor L. Garren Du et al.	
	Art Unit 3621	Examiner Jalatee Worjloh
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>45,884</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: center;">  _____ Signature _____ Mandy Jubang Typed or printed name _____ (617) 542-5070 Telephone number _____ January 23, 2007 Date </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>		
<input type="checkbox"/> Total of no. forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: L. Garren Du et al.	Art Unit	: 3621
Serial No.	: 09/879,267	Examiner	: Jalatee Worjloh
Filed	: June 12, 2001	Conf. No.	: 3522
Title	: DIGITAL CONTENT PUBLICATION		

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 – New Pre-Appeal Brief Conference Pilot Program, a request for a review of the identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal and factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-40, 43, 44 and 50-55 are pending with claims 1, 14, 27, 40 and 54 being independent. Claims 1-5, 10, 14-18, 23, 27-31, 36, 40, 43, and 50-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki et al. (US Pub. No. 2002/0077988; “Sasaki”) in view of Niwa (US 2003/0225696). Claims 6, 9, 19, 22, 32, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Niwa. Claims 7, 13, 20, 33, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Niwa and further in view of Downs et al. (US 6,226,618). Claims 8, 21, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Niwa and further in view of Saito et al. (EP 1041823). Claims 11, 12, 24, 25, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Niwa and further in view of Padhye et al. (US Pub. No. 2003/0023564; “Padhye”). The applicant respectfully traverses these rejections.

The applicant specifically request the panel to review the following issue: the combination of Sasaki and Niwa fails to support a *prima facie* case of obviousness with respect to claim 1. The applicant reserves the right to expand on this issue and/or present new issues when filing an appeal brief.

Discussion of issue:

The combination of Sasaki and Niwa fails to support a prima facie case of obviousness with respect to claim 1.

Sasaki and Niwa, either alone or in combination, fail to describe or suggest all features and limitations of claim 1. In particular, Sasaki and Niwa fail to describe or suggest “receiving publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content; storing the digital content at a first computing system; and sending the metadata and the publication information to a second computing system for storage separately from the first computing system,” as recited in claim 1. Thus, the combination of these references fails to support a prima facie case of obviousness.

In the Office Action mailed October 23, 2006, the examiner appears to take the position that Niwa's teaching of the storage of information describing the content of video segments separate from the storage of the video segments (see paragraphs [0072] and [0073]; elements 130 and 132 of FIG. 1) makes obvious “sending the metadata and the publication information [comprising distribution information that identifies one or more content distributors selected to distribute the digital content] to a second computing system for storage separately from the first computing system.” The applicant disagrees. Niwa does not disclose or suggest “content distributors selected to distribute the digital content.” Accordingly, there is no reason for the Niwa system to “[receive] publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content,” much less “[send] ... the publication information to a second computing system for storage separately from the first computing system,” as recited in claim 1.

Further, even if Niwa's “information describing content” were to include “publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content” as the examiner suggests, the applicant submits that it would not have been obvious to a skilled artisan to modify Sasaki to include the feature of “sending the metadata and the publication information to a second computing system for storage separately from the first computing system ...” even if it were technically feasible to do so as

such a modification would change the principle of operation of the Sasaki system and render it unsatisfactory for its intended purpose.

In the Summary section, Sasaki states

The invention features a novel digital content distribution scheme that enables digital content owners to reach new potential customers by leveraging the desire of users to share and exchange digital content, while protecting the commercial interests of digital content owners. The invention enables users to fully enjoy digital content and, at the same time, the invention prevents unchecked distribution of unlicensed digital content. The invention also features a novel content tracking and incentives system that encourages commercial distributors, broadcasters and users to distribute digital content to new potential customers.

To achieve these objectives, the Sasaki system packages a digital content and its associated metadata into an encrypted transfer file that may be securely transmitted from one entity to another in a distribution path between a license manager and an end user. (see paragraphs [0041]-[0043] for details). The metadata associated with the digital content includes one or more distributor and user identifiers, which correspond to the one or more entities in the distribution path. (paragraph [0038]). These identifiers enable the license manager to identify where distribution-based incentive points or commissions should go each time a distribution transaction takes place (e.g., during a purchase of content via a kiosk or PC and the upgrading of content to a full license). (paragraph [0050]). These identifiers also enable the Sasaki system to track the distribution of the digital content to end users (both licensed and unlicensed):

End-users 26, 28 must register their portable media devices and playback software programs with license manager 22 in order to participate in the distribution system 10. During registration, a portable media device is associated with information relating to the owner of the device. The ownership information may be embedded in the portable media device and may be stored in a license database controlled by license manager 22. (paragraph [0040]).

The user does not have direct access to this ownership information, which is also referred to in Sasaki as a "user identifier." (paragraph [0042]).

When a user purchases digital content, the commercial distributor retrieves the user identifier corresponding to the recipient user from the license database, generates metadata including the retrieved user identifier and license restriction codes, and packages the metadata with the digital content into a single content package prior to pushing the content package down the distribution path to the recipient user. When a user's portable media device receives a content package, a playback software program compares the user identifier embedded in the media device itself with the user identifier included in the metadata of the content package. If there is a match, the user is considered a "licensed user" and playback of the digital content is permitted an unlimited number of times. If no match is made, the user is considered an "unlicensed user" and playback of the digital content is permitted a limited number of times as specified by license restriction codes included in the metadata of the content package. (see paragraph [0044]).

In order for this "match" or "no match" evaluation to be performed, all embodiments of the Sasaki system require metadata specifying a user identifier to be included with the digital content in the content package that is passed down the distribution path. This aspect of Sasaki is critical to its ability to combat unchecked distribution of digital content, while encouraging distribution of the digital content to potential customers. The examiner's assertion that "storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content" is clearly contrary to the actual teachings of Sasaki. Separating the metadata (which in Sasaki includes a user identifier and a distributor identifier) from the digital content at any point along the distribution path by storing the digital content in a first computing system while sending the metadata to a second computing system for storage separately from the first computing system would expose the digital content of Sasaki and defeat the stated objectives of Sasaki's invention. The applicant maintains that it would not have been obvious to a person of ordinary skill in the art modify Sasaki to "[store] the digital content at a first computing system; and [send] the metadata and the publication information to a second computing system for storage separately from the first computing system ..." as suggested by the examiner.

For the reasons stated above, independent claim 1 is patentable over the prior art.

The foregoing remarks also apply to independent claims 14, 27, 40, and 54, which have corresponding limitations. All of the dependent claims are patentable for at least the same reasons given with respect to the independent claims from which they depend.

In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

1/23/07



Mandy Jubang
Reg. No. 45,884

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
21537882.doc